

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/129,238 08/05/98 SARDY

V 4101-0206-55

022850 IM22/0109  
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EXAMINER

YEE, D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1742

18

DATE MAILED:

01/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

|          |                 |               |  |
|----------|-----------------|---------------|--|
|          | Application No. | Applicant(s)  |  |
|          | 09/129,238      | SARDOY ET AL. |  |
| Examiner | Deborah Yee     | Art Unit      |  |
|          |                 | 1742          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 16 November 2000.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) Notice of References Cited (PTO-892)      18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)      19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      20) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The request filed on 11-16-00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/129,238 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 556834 for the reasons set forth in the previous office action of paper no18.

### ***Response to Arguments***

Applicant's arguments filed 11-16-00 have been fully considered but they are not persuasive. It was argued that in the process of EP'834, there is no overlap in coiling temperature between the present claims and the disclosure of the reference, nor does the reference disclose or describe the preferred characteristics provided. It is the examiner's position that EP'834, lines 1 to 10 on page 8 discloses a coiling temperature of 400 to 600C with a preferred range of 530C or less. Applicant's claim a coiling temperature range of >530C to 620C, which fails to define patentable novelty over EP'834 since there is nothing (e.g. comparative test data) to show that the more

narrowly claimed coiling temperature range is critical and productive of new and unexpected results. Note that applicant's specification indicates that >530 to 570C is preferred but a broad coiling temperature range of 450 to 620C is permissible.

Moreover, similar to the present invention, EP'834 discloses a steel product having very good drawability with an average r value of 1.5 or greater (see Table 3) which closely meets the average r value of greater than 1.6 recited in claim 14. Although prior art does not disclose plain anisotropy coefficient to be 0.08 to 0.12 as recited by claim 21, such would be inherent since the compositional and process limitations are closely met, and in absence of proof to the contrary.

In regard to the steel containing at most 0.001% for each Nb and Ti recited by claim 8, note that EP'834 steel contains 0.01 to 0.01% for each Nb and Ti as optional elements and therefore can be excluded. Hence claimed steel alloy would not patentably distinguish over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 703-308-1102. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

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Art Unit: 1742

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

dy  
January 8, 2001

  
**DEBORAH YEE**  
**PRIMARY EXAMINER**